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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/724,711

Filing Date: December 02, 2003

Appellant(s): WEEDMARK ET AL.

Mark R. Woodall
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26FEB2008 appealing from the Office action mailed 23AUG2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,643,267 B1 Karia et al. NOV 2003

ITU-T, "Series Q: Switching and Signalling Broadband ISDN-- B-ISDN application protocols for access signalling, Digital Subscriber Signalling System No. 2- connection modification: peak cell rate modification by the connection owner", Q.2963.1, 12/99

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 rejected under 35 U.S.C. 102(e) as being anticipated by **Karia et al. (US Patent Number: US 6,643,267 B1).**

a) Consider **claim 1**, Karia et al. clearly show and disclose an active connection modify in a connection oriented communication network (inherently taught by the use of ATM networks which by definition incorporate the ability to do an active connection modify and are by nature connection oriented. see columns 1, column 2, figure 1, figure 2), comprising the steps of: appending a trace transit list information element (TTL IE) to a Modify Request message (figure 2, figure 3, column 2 lines 7-9)), transmitting said Modify Request message from a source node to a destination node along said active connection (column 1 lines 27 – 30, column 2 lines 22-23 lines 29-31), and at each node along said active connection, modifying a parameter of said active connection (inherently taught by the use of ATM networks which by definition incorporate the reservation of resources in conjunction with a Modify Request message) while recording in said TTL IE failure identification data(inherently taught in column 2 lines 34-41, column 3 lines 42-43).

b) Consider **claim 2** and **as applied to claim 1 above**, generating a Modify Reject message at a node along said connection if said node does not enable modification of said parameter (inherently taught by the use of ATM networks which by definition generates a Modify reject message when a node does not enable modification or when there are insufficient resources to accommodate the modification request), updating said TTL IE from said Modify Request message with failure cause information (column 3 lines 41-44, inherently taught by use of ATM network which by definition incorporates Modify reject message that includes the cause of the failure), and appending said TTL IE to said Modify Reject message and returning said Modify Reject message to

said source node (Inherently taught by Karia et al. which returns failure information for failed paths via the acknowledge message).

c) Consider **claim 3** and **as applied to claim 1 above**, wherein said failure identification data (inherently taught in column 2 lines 34-41 “not including the failed paths” implies that failed path can be recorded in the TTL IE, column 3 lines 42-43) includes the logical node and logical port trace of the failed Modify Request (figure 3, figure 5, column 3 lines 16-17, column 6 lines 13-48).

d) Consider **claim 4** and **as applied to claim 1 above**, wherein said failure identification data (inherently taught in column 2 lines 34-41 “not including the failed paths” implies that failed path can be recorded in the TTL IE, column 3 lines 42-43) includes failure cause information (column 3 lines 41-44).

e) Consider **claim 5** and **as applied to claim 4 above**, wherein said failure cause information (column 3 lines 42-43) includes vendor specific information (abstract, figure 3, figure 4, column 4 lines 3-4 lines 12-16 lines 61-66).

f) Consider **claim 6** and **as applied to claim 1 above**, wherein said parameter is the bandwidth allocated to said connection (inherently taught by the use of ATM networks which by definition incorporate the ability to modify traffic parameters).

g) Consider **claim 7** and **as applied to claim 1 above**, wherein said failure to modify includes the capability of a node along said connection to support the modify of an active connection of said parameter (inherently taught by use of ATM networks which by definition return a Modify Reject message with failure cause information if the node enables modification of traffic parameters).

h) Consider **claim 8**, and **as applied to claim 1 above**, further comprising: generating a Modify Acknowledgement message at said destination node if all nodes along said connection

enable modification of said parameter (inherently taught by the use of ATM networks which use the Modify Acknowledge sent from the destination node to the requesting node if the connection defined by the Modify Request is available for use); transmitting said Modify Acknowledgement message to said source node (abstract, column 2 lines 63-67, column 3 lines 1-4, column 4 lines 24-28, column 8 lines 12-17); and transmitting traffic from said source node to said destination node along said connection with said modified parameter (a virtual circuit is set up across the ATM network prior to transferring data which would include the specification of traffic parameters necessary to transmit the traffic)(column 1 lines 24-30)(also inherently taught by the use of ATM networks in which the requesting node transmits based on the request modified transmit traffic parameters).

In anticipation of Appellant's challenge, the Examiner has cited the following factual evidence in supporting the inherency of features of ATM networks in Karia, in the 18DEC2006 First Office Action. Upon Appellant's challenge in 17MAY2007, the Examiner has again cited the following factual evidences in supporting the inherency of features of ATM networks in Karia, in the 10AUG2007 Final Office Action:

- a) ATM supports active connection modify in a connection oriented network (ITU-T Q2963.1 section 1 paragraph 1 line 5 paragraph 3 paragraph 4 lines 1-2 and as admitted by Applicant. (paragraph [0002] lines1-3, paragraph [0003]))
- b) Resources are reserved in conjunction with a Modify Request message (ITU-T Q2963.1 section 9.1.1 lines 3 and 5 and as admitted by Applicant. (paragraph [0004] lines 1-7, paragraph [0005] lines 16-22))

- c) A Modify Reject message sent when modification is not supported or resources are not available to support the modification and as admitted by Applicant. (ITU-T section 9.1.4 lines 2-5 and as admitted by Applicant. (paragraph [0005] lines 1-16))
- d) A Modify Reject message includes cause of failure (ITU-T Q.2963.1 section 8.1.3 table 8-3/Q.2963.1)
- e) ATM supports the modification of traffic parameters (ITU-T Q.2963.1 section 3.2 section 91.1 section 9.1.2 section 9.1.3 and as admitted by Applicant. (paragraph [0002] lines 3-11 and paragraph [0003]))
- f) A Modify Reject message contains the cause of failure if a node enables modification of traffic parameters (ITU-T Q.2963.1 table 8-3/Q.2963.1)
- g) A Modify Acknowledge message is generated at the destination node and sent to the requesting node when resources along the path are allocated and available for use. (ITU-T Q.2963.1 table 8-2/Q.2963.1 section 8.1.2, section 9.1.2)

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellants and addresses replies individually.

As per Appellants' argument that:

Argument (1) "In the Response to Arguments section, both in section 4 on page 5 and extensively in section 5 on page 6, the Response to Arguments relies on documents made of record by Appellant. Appellant respectfully submits that the rejection's reliance on these many documents in connection with the rejection, without applying the documents as documents relied upon as the basis for the rejection, is improper.

Appellant respectfully submits that, in order to be properly crafted, the rejection should be listed as a rejection(s) under 35 U.S.C. § 103(a) based on combinations of Karia and the additional documents relied upon in the Response to Arguments sections 4 and 5 on pages 5 and 6. Appellant respectfully submits that, even assuming *arguendo* that the Office Action's reliance on the many documents is proper, which it is not, at a minimum the rejection is reversible due to its failure to apply all the documents relied upon for the rejection."

Appellant's argument that the Examiner's reliance on inherency in the rejection is excessive and improper appears multiple times throughout the Appellant's argument is addressed in full below.

In reply to Argument (1) the Examiner's asserts that rejection's reliance on these documents in connection with the rejection, without applying the documents as documents relied upon as the basis for the rejection, is proper.

MPEP 2131.01 stated:

2131.01 *Multiple Reference 35 U.S.C. 102 Rejections*

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) *Prove the primary reference contains an "enabled disclosure;"*
- (B) *Explain the meaning of a term used in the primary reference; or*
- (C) *Show that a characteristic not disclosed in the reference is inherent.*

See paragraphs I-III below for more explanation of each circumstance.

***III. TO SHOW THAT A CHARACTERISTIC NOT DISCLOSED IN THE
REFERENCE IS INHERENT***

*Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the
Thing Taught by the Primary Reference*

*“To serve as an anticipation when the reference is silent about the asserted inherent
characteristic, such gap in the reference may be filled with recourse to extrinsic evidence.
Such evidence must make clear that the missing descriptive matter is necessarily present in
the thing described in the reference, and that it would be so recognized by persons of
ordinary skill.” Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20
USPQ2d 1746, 1749 (Fed. Cir. 1991) (The court went on to explain that “this modest
flexibility in the rule that anticipation’ requires that every element of the claims appear in a
single reference accommodates situations in which the common knowledge of
technologists is not recorded in the reference; that is, where technological facts are
known to those in the field of the invention, albeit not known to judges.” 948 F.2d at
1268, 20 USPQ at 1749-50.).*

Accordingly, the Examiner has made a proper multiple reference 102 rejection to show that the characteristic not disclosed in Karia is inherent. Karia clearly discloses the claimed invention and specifically discloses the use of ATM networks (column 1 lines 24-30, column 4 lines 59-67). The reference (ITU-T Q.2963.1) discloses asserted characteristics of ATM networks that would have been obvious to a person of ordinary skill in the art but not necessarily specifically shown in Karia (ITU-T Q.2963.1 table 8-1,(Q.2963.1 notes 3 and 4, section 3.2, section 5, section 9.1.1, section

9.1.2). These features are an inseparable part of ATM networks and would thus be well known to a person of ordinary skill in the art. Evidence supporting the inherency of the claimed features was clearly sited and provided in all Office Actions. In addition to the evidence sited in ITU-T Q.2963.1 to support the inherency there are the admissions in the Background of Invention by Appellant of known features of ATM networks (paragraph [0002], lines 3-11, paragraph [0003], paragraph [0004], lines 1-7, paragraph [0005], lines 16-22).

Appellant fails to put forth any specific argument with regards to the inherency aside from the “modifying a parameter” (which is addressed in argument (3)). The Examiner has repeatedly shown support for the inherency of claimed features in both the ITU-T Q.2963.1 reference and as admitted by Appellant in the Background of Invention.

In anticipation of Appellant’s challenge, the Examiner has cited the following factual evidence in supporting the inherency of features of ATM networks in Karia, in the 18DEC2006 First Office Action. Upon Appellant’s challenge in 17MAY2007, the Examiner has again cited the following factual evidences in supporting the inherency of features of ATM networks in Karia, in the 10AUG2007 Final Office Action:

- a) ATM supports active connection modify in a connection oriented network (ITU-T Q2963.1 section 1 paragraph 1 line 5 paragraph 3 paragraph 4 lines 1-2 and as admitted by Applicant. (paragraph [0002] lines1-3, paragraph [0003]))
- b) Resources are reserved in conjunction with a Modify Request message (ITU-T Q2963.1 section 9.1.1 lines 3 and 5 and as admitted by Applicant. (paragraph [0004] lines 1-7, paragraph [0005] lines 16-22))

- c) A Modify Reject message sent when modification is not supported or resources are not available to support the modification and as admitted by Applicant. (ITU-T section 9.1.4 lines 2-5 and as admitted by Applicant. (paragraph [0005] lines 1-16))
- d) A Modify Reject message includes cause of failure (ITU-T Q.2963.1 section 8.1.3 table 8-3/Q.2963.1)
- e) ATM supports the modification of traffic parameters (ITU-T Q.2963.1 section 3.2 section 91.1 section 9.1.2 section 9.1.3 and as admitted by Applicant. (paragraph [0002] lines 3-11 and paragraph [0003]))
- f) A Modify Reject message contains the cause of failure if a node enables modification of traffic parameters (ITU-T Q.2963.1 table 8-3/Q.2963.1)
- g) A Modify Acknowledge message is generated at the destination node and sent to the requesting node when resources along the path are allocated and available for use. (ITU-T Q.2963.1 table 8-2/Q.2963.1 section 8.1.2, section 9.1.2)

As to the Examiner's "excessive" reliance on inherency, it is in fact not excessive. The reference (ITU-T Q.2963.1) has merely shown features of ATM networks that are well known and obvious to one of ordinary skill in the art. They are all features of ATM networks, which are used by Karia, and thus would have been apparent to one of ordinary skill in the art as being necessary to ATM networks and Karia.

Furthermore, whether the documents were made of record by Appellant has no bearing on how they are applied for the purposes of rejection.

Argument (2) “Appellant notes that the rejection of claims 1-7 is repeated verbatim from the rejection of those claims that appeared in the December 27, 2006, non-final Office Action. In response thereto, Appellant pointed out that the rejection correctly concedes that Karia fails to disclose, teach or suggest a large portion of the subject matter recited in the rejected claims. In fact, Appellant respectfully asserts that the rejection correctly concedes that Karia fails to disclose, teach or suggest significantly more than half of the subject matter recited in the rejected claims! On this basis alone, Appellant respectfully asserts that the Office Action has excessively and improperly relied on allegations of inherency in putting forth the rejection. Appellant respectfully asserts that the rejection should be reversed on this basis alone.”

In reply to Argument (2) the Examiner at no time conceded that Karia fails to disclose, teach, or suggest the subject matter recited in the rejected claims. The Appellant seems to confuse the concept of inherency with the failure of a reference to disclose subject matter and thus necessitate the combination with a secondary reference to account for a deficiency in the primary reference.

Karia clearly discloses the claimed invention operating in ATM networks and thus does not require a secondary reference. The claimed features rejected using inherency are inseparable from of ATM networks are thus inherent in Karia.

MPEP 2112 stated:

2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. “The inherent teaching of a prior

art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

ITU-T Q.2963.1 was introduced as support for this inherency in a proper multiple reference 102 rejection. ITU-T Q.2963.1 clearly shows that the claimed features are part of ATM networks. Clearly showing that the features of the claimed invention are characteristic of ATM networks and obvious to one of ordinary skill in the art. Karia is relying on ATM networks and thus these features are disclosed in Karia.

Argument (3) "Claim 1 recites three steps in a method. One of the three steps recited in claim 1 is the step of "modifying a parameter." The Office Action relies entirely on an inherency argument with respect to this step in the recited method. Appellant respectfully submits that the step of modifying a parameter, according to the combination recited in claim 1, is not inherently disclosed by Karia. In fact, it is respectfully submitted that this deficiency in the rejection is evident even by the Office Action's own assertion regarding what is allegedly inherent. Specifically, "the use of ATM networks which by definition incorporate the reservation of resources in conjunction with a Modify Request message" in no way describes "modifying a parameter" as recited in claim 1.

In sections 4 and 5 on pages 5 and 6, the Final Office Action includes a Response to Arguments section. However, the Response to Arguments section entirely ignores Appellant's argument that the reliance on inherency in the rejection is excessive and improper."

In reply to Argument (3) Appellant argues because of reliance on an inherency argument that the step of modifying a parameter as recited in claim 1 is not disclosed by Karia, Appellant also argues that this deficiency in the rejection is evident even by the Office Action's own assertion regarding what is allegedly inherent. Specifically, "the use of *ATM* networks which by definition incorporate the reservation of resources in conjunction with a Modify Request message" in no way describes "modifying a parameter" as recited in claim 1.

Both the ITU-T Q.2963.1 document submitted by Appellant (ITU-T Q.2963.1 table 8-1/Q.2963.1 notes 3 and 4, section 3.2, section 5, section 9.1.1, section 9.1.2) and Appellant's admissions (paragraph [0002] lines 3-11, paragraph [0003], paragraph [0004] lines 1-7, paragraph [0005] lines 16-22) show modification of parameters in an active connection ATM network.

Karia incorporates connection-oriented networks such as ATM networks using TTL (column 1 lines 14-30, column 4 lines 59-67).

Therefore the ability or modify parameters is inherently disclosed by Karia et al., specifically "the use of ATM networks which by definition incorporate the reservation of resources in conjunction with Modify Request message" does describe "modifying a parameter" as recited in claim 1 (ITU-T Q.2963.1 table 8-1/Q.2963.1 notes 3 and 4, section 3.2, section 5, section 9.1.1, section 9.2.1, section 9.2.2; as admitted by Appellant paragraph [0002] lines 3-11, paragraph [0003], paragraph [0004] lines 1-7, paragraph [0005] lines 16-22).

Furthermore, as stated above, inherency is not equivalent to a deficiency requiring a second reference in combination. Karia discloses the claimed invention and specifically discloses the use of ATM networks. ITU-1 Q2963.1 merely shows the details of what was obvious to one of ordinary skill in the art at the time the invention was made.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DCM

/DCM/

Conferees:

/Kenny S Lin/

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